

REMARKS

This is responsive to the Office action mailed in this application on June 27, 2002. In that action, the Examiner rejected all of the claims pursuant to 35 U.S.C. §112 and 35 U.S.C. §103(a). Applicant respectfully traverses the rejection of each claim for the reasons set forth below.

Claim Rejections - 35 USC § 112

Claim 59 was rejected under 35 U.S.C. 112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to make or use the invention. In rejecting a claim based upon 35 U.S.C. §112, first paragraph, the Examiner has the burden to establish a “reasonable basis to question the enablement provided for the claimed invention.” MPEP §2164.04, *citing In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). The Examiner must do more than state that a claim is not enabled, it is “incumbent on the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.” *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971), cited in MPEP §2164.04.

According to the Examiner, claim 59, “wherein the amount of said predetermined credit is not a function of the balance in the player account” is not enabled because if the predetermined amount were set at \$50, but the player account had only \$10, there is no suggestion that the transfer would be made. Office Action, page 2. The Examiner states that this makes the transferred amount a function of the balance.

Applicant’s disclosure includes the following, beginning at page 10, line 26 and continuing to page 11, line 2:

After the player record is stored at MCI 50, the player uses keypad 80 to select cashless play. An algorithm that is part of the software stored in read only memory (ROM) (not shown) in MCI 50 then calculates an amount to transfer from the account in MCI 50 to credit meter 70 on EGM 12. The amount transferred is a predetermined amount calculated by the algorithm; it is not selected by the player using keypad 80. The algorithm checks flags associated with the account for minimum and maximum transfer limits that are imposed at one of terminals 90, 92 when the account is opened. These minimums and maximums are set regardless of the account balance. The algorithm, of course,

also examines the account balance and does not permit a transfer in access of the account balance.

Therefore, the Examiner's analogy is incorrect. The predetermined amount is not a function of the player's balance. Whether or not a transfer is made at all is. These are two separate concepts. Claim 59 is supported by the specification and is enabled.

Claim Rejections - 35 USC § 102

It is well settled that a rejection based on anticipation requires the disclosure, in a single reference, of every element the applicant claims as his invention. *Ex parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Int'l 1990). In making such a rejection, it is the examiner's burden to identify where each element of the Applicant's invention is disclosed in the prior art. *See id.* The Examiner has failed to meet this burden with respect to Applicant's invention.

Claims 33, 36, 40 & 43-49 are rejected under 35 U.S.C. 102(b) as anticipated by LeStrange, et al (U.S. Patent No. 5,470,079) ("LeStrange").

As to claim 33, the Examiner states that LeStrange discloses a method of operating gaming devices interconnected by a network to a host computer, including a player account accessible by the host computer responsive to a player initiated command. Office Action, page 2. The Examiner failed to address the limitation in claim 33 "providing access to the account responsive to a **command initiated by a player at one of the gaming devices.**" [Emphasis added]. LeStrange does not disclose this feature.

The Examiner also argues that a first and second meter reading in association with transferring credit between the account and the gaming device is inherent in maintaining an audit trail. Office Action, page 20. Although maintaining an audit trail may be disclosed, there is nothing to suggest that such an audit trail need be comprised of a first and second meter reading. Indeed, the section quoted by the Examiner demonstrates that this type of audit trail teaches away from Applicants' invention.

Specifically, at column 7, lines 2-4, LeStrange only says that whenever the system updates meter values, the event that caused the changes is also recorded. The type of event that causes the meter value to be updated is described in column 6, lines 60-66: "Possible events include: coin or other money input by the player, wagers placed by the player, game wins issued to the player, a 'collect' event issued by the player signifying the player's desire to withdraw

available game credit from the machine and a game change event signifying that a player has requested a change of game at a video lottery machine.” Nowhere does it refer to reading a meter a first time and reading the meter a second time.

In sharp contrast, the stated events in LeStrange are all actions undertaken by the player and not actions undertaken by the system, such as the meter readings, to ensure the integrity of the system. As such, LeStrange teaches away from Applicant’s invention. Claims 36, 40, and 43-49 are allowable because they depend from an allowable claim.

Claim Rejections - 35 USC § 103

A proper obviousness rejection must be based on basic tenets of patent law. According to the Manual of Patent Examining Procedure these tenets are: 1) the invention must be considered as a whole; 2) the references must be considered as a whole and must suggest the desirability and obviousness of the combination; 3) the references must be viewed without hindsight; and 4) there must be a reasonable expectation of success. MPEP §2141. The incentive to combine references must also be readily apparent. If the incentive to combine is not readily apparent, the Examiner must explain why the combination of teachings is proper. *See Ex parte Skinner*, 2 USPQ2d 1788, 1790 (B. App. & Int’f 1986). The Examiner has failed to meet this burden.

Claims 1-10 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch, et. al. (U.S. Patent No. 5,967,896) (“Jorasch”) in view of Kishishita (U.S. Patent No. 4,880,237) (“Kishishita”). Claims 11& 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch and Kishishita in view of LeStrange. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch, Kishishita and LeStrange in view of Walker, et. al. (U.S. Patent No. 6,227,972) (“Walker”).

As to claim 1, the Examiner says that Jorasch discloses gaming machines interconnected by a network to a host computer, a player account accessible by the host computer, accessing the account responsive to a first command issued by the player, transferring credits from the account to the gaming device, and cashing out the player responsive to a second player command at the gaming device. Office Action, page 5. According to the Examiner, although Jorasch does not teach anonymous accounts, Kishishita does.

The Examiner cites Kishishita, column 3, lines 54-64, in support of his argument. Applicant has amended claim 1 to read “creating an anonymous player account at an automated

card dispenser.” Kishishita does not teach creating an anonymous player account at an automated card dispenser. In Kishishita, the player goes to a game data processing unit which is generally provided at a reception desk. There is no suggestion that the game data processing unit is an automated card dispenser.

For obviousness to exist, “either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Cited by MPEP 2142. The combination of references does not expressly or impliedly suggest the claimed invention.

It was apparently not obvious to developers of the Jorasch system to include Kishishita’s anonymous player accounts because they did not do so. Jorasch was filed nine years after Kishishita issued. Were the combination so obvious and desirable, Jorasch would have used Kishishita’s anonymous accounts. Claims 2-8 are likewise allowable because they depend from an allowable claim.

With respect to claim 9, the Examiner states that Jorasch and Kishishita teach the invention substantially as claimed. Office Action, page 6. However, while stating that both references teach the importance of accurate accounting, the Examiner admits that the applied references do not teach the details of accounting for the balance transferred.

The Examiner has cited Kishishita, column 4, lines 55-62, as supporting this position. The audit trail in Kishishita keeps track of the game media (coins, balls, etc.) put in the games, the number of game media expelled at wins, and the ratio between the values. In essence, Kishishita is tracking the ratio of games to wins. There is no suggestion that this tracking is related to a player or a player balance. Rather the tracking relates to a particular machine and whether the machine has any game media left.

Jorasch likewise fails to disclose Applicant’s claim 9. The Examiner has not directed Applicant to any portion of Jorasch to support his assertion that together Jorasch and Kishishita teach the invention as claimed. Indeed Jorasch does not discuss how the system involved keeps the several balances or accounts separate or ensures that accurate transfers between balances are made. Moreover, because Jorasch is an invention directed to controlling a gaming device with a

plurality of balances, even if it were enabling on audit tracking, which it is clearly not, Jorasch would operate much differently than Applicant's claim 9.

Jorasch would have to reconcile pre and post-transfer meter readings among a plurality of balances and would have to ensure that the correct balance was adjusted by the correct transfer amount. As such, Jorasch would not be able to perform this function as does Applicant. Although careful accounting may be known in the art, Applicant's method of performing careful accounting is not. Claims 10-16 are allowable because they depend from an allowable claim.

With respect to the combination of Jorasch and Kishishita, Applicant submits that neither of these references teaches separately the claimed invention, nor do they teach the claimed invention in combination. Combining these references would produce an audit tracking system that tracked the ratio of plays to wins in a multi-balance setting, without disclosing how that is actually done. This is not Applicant's invention. Applicant's invention has significant features that are not disclosed by the combination of references.

Claims 17-30, 32, 55 & 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorasch in view of LeStrange.

With respect to claim 17, the Examiner says that Jorasch does not disclose transferring a predetermined amount but that LeStrange does. According to the Examiner, the motivation for doing so is to comply with state gambling laws. In support the Examiner cites to LeStrange, column 8, lines 9-13. This particular selection describes the types of credit that can be played, such as promotional tickets or debit cards with specified dollar amounts. It falls short of disclosing "transferring a predetermined credit from the account to the gaming device responsive to a transfer command initiated by the player at said one gaming device."

When applying prior art references to make an obviousness rejection, an examiner cannot pick and choose the attributes of each reference he would like to combine and ignore the others. "A prior art reference must be considered in its entirety . . . including portions that would lead away from the claimed invention." MPEP 2141.02 citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Considering these references in their entirety, Applicant's invention is not obvious.

With respect to the combination of Jorasch and LeStrange, Applicant submits that neither of these references teaches separately the claimed invention, nor do they teach the claimed invention in combination. Combining these references would produce a system that used

promotional tickets or debit cards to allow the player to select one or more balances for transfer. This is not Applicant's invention.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-35 and 37-61, as amended, of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

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IN THE SPECIFICATION

Please replace the paragraph beginning on page 10, line 26 and ending on page 11, line 4 with the following:

After the player record is stored at MCI 50, the player uses keypad 80 to select cashless play. An algorithm that is part of the software stored in read only memory (ROM) (not shown) in MCI 50 then calculates an amount to transfer from the account in MCI 50 to credit meter 70 on EGM 12. The amount transferred is a predetermined amount calculated by the algorithm; it is not selected by the player using keypad 80. The algorithm checks flags associated with the account for minimum and maximum transfer limits that are imposed at one of terminals 90, 92 when the account is opened. These minimums and maximums are set regardless of the account balance. The algorithm, of course, also examines the account balance and does not permit a transfer in [access] excess of the account balance. The ability to set maximum limits regardless of account balance is a tool that can be used to address problem gamblers, among other things.

IN THE CLAIMS

1. (Twice Amended) A method for operating gaming devices interconnected by a network to a host computer comprising:

creating an anonymous player account at an automated card dispenser, said account being accessible by the host computer;

providing access to the account responsive to a first command initiated by a player at one of the gaming devices;

transferring credit from the account to the gaming device;

permitting gaming device play; and

cashing out from the gaming device responsive to a second command initiated by said player at said one gaming device.

3. (Twice Amended) The method of claim 2 wherein said gaming devices are in a casino [and wherein creating a player account accessible by the host computer is performed at an automated card dispenser].